

SUGIYAMA et al.  
Appl. No. 09/801,672

### **REMARKS/ARGUMENTS**

Entry of the present Amendment and reconsideration of all claims remaining of record as presently amended are earnestly requested. Claims 1-30 and 32 are currently pending. By this amendment, claims 1, 8 and 23 are canceled without prejudice or disclaimer and new claims 33-37 are added. Applicants respectfully submit that newly added claims 33-37 set forth combinations of features recited in claims previously presented and considered and, therefore, should not require further additional searching.

The rejection of claims 30 and 32 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter is respectfully traversed. Claim 30 has been amended to positively recite that the storage medium is computer readable. Claim 32 has been amended to more distinctly claim a computer propagated signal embodied in a carrier wave or other transmission medium as an article of manufacture. As such, Applicants respectfully contend that both claims 30 and 32 are now clearly directed toward statutory subject matter.

The rejection of claims 1-7, 12-22, 26-30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. (USP 6,356,908) and Carpenter et al. (USP 6,754,174) is respectfully traversed. Claim 1 has been canceled without prejudice or disclaimer. Independent claim 2 has been amended to incorporate the features of dependent claim 8 and independent claim 17 has been amended to incorporate the features of dependent claim 23. As such, dependent claims 3-7 and 9-16 now incorporate the additional limitations of amended base claim 2 from which they depend.

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Likewise, dependent claims 18-22 and 24-29, which are dependent on base claim 17, now incorporate the additional limitations of that base claim as amended.

The final Office Action mailed April 7, 2004 (Paper No. 7), indicated that claims 8 and 26 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. At paragraph 10, the Office Action states "the Examiner has carefully considered claims 8 and 23. None of the prior art of record fairly teaches or suggests the limitations . . ." [further reciting the language of dependent claims 8 and 23]. "These limitations define patentably over relevant prior art made of record." Since claims 3-7, 9-16, 18-22 and 24-29 are now all dependent upon at least one base claim that was indicated by the Examiner in the final office action as being allowable, applicants respectfully contend that these claims are now in condition for allowance and respectfully request that they be passed to issue.

In addition, Independent claims 30 and 32 have both been amended to incorporate the indicated patentable features of amended claim 23. Applicants respectfully contend that these claims are now also in condition for allowance.

Applicants wish to thank Examiner Vu for granting the request for a personal interview with Applicants' representative on July 8, 2004. The substance of that interview is summarized immediately below:

Statement of the Substance of the July 8, 2004 Interview with the Examiner

An interview was conducted between Applicants' representative, Mr. Niessen, and Examiner Vu on July 8, 2004 at the U.S. Patent and Trademark Office to discuss claims 4, 19 and 13.

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Examiner Vu discussed the outstanding rejection of claims 30 and 32 under 35 U.S.C. § 101 and suggested that claim 32 could be amended at line 1 to recite either a "computer propagated signal stored in a medium that is computer readable . . ." or a "computer propagated signal exciting . . ." so as to overcome the non-statutory subject matter rejection.

Mr. Niessen reviewed and discussed the prior art of record with respect to the features recited in Applicants' previously presented claims 4, 19 and 13. Examiner Vu indicated that dependent claims 4, 19 and 13 would be allowable as previously presented if the base independent claims 2 and 17, upon which those claims depend, were amended to include the indicated patentable features of claims 8 and 23, respectively.

Mr. Niessen also proposed adding new independent claims 33-35 which would respectively incorporate the features of original base claims 2, 17 and 12 and include clarifying amendments to the previously presented claims 4, 19 and 13 that would more particularly point out and distinctly claim Applicants' invention<sup>1</sup>. Additional new claims dependent on claims 33-35 were also proposed. Examiner Vu agreed that the proposed new claims which incorporate the features of claims 4, 19 and 13 and the proposed clarifying amendments would distinguish over the prior art of record, but stated that further searching and consideration would be required before the new claims could be allowed.

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<sup>1</sup> The proposed clarifying amendment to claims 4 and 19 consisted of the additional wording "wherein the item-specific rearrange step is automatically performed in response to a manipulation of a displayed item selection button"; the proposed clarifying amendment to claim 13 consisted of the additional wording "wherein each different color corresponds to a particular image information storage region".


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In view of Applicants' foregoing remarks and amendments, it is believed that the application is in condition for allowance. Favorable consideration and allowance of this application are respectfully solicited. If any small matter remains outstanding, the Examiner is encouraged to telephone Applicants' representative at the telephone number listed below or on the following page.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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